

REMARKS

Claims 1-32 are pending in the present application.

Claim 29-32 are newly added herein.

Reconsideration on the merits is respectfully requested.

The claims are believed to be allowable for the reasons set forth herein. Notice thereof is respectfully requested.

Drawings

The drawings are objected to because the grounded means should be shown grounded. The Office has also requested that the figure be further annotated with names for certain elements in addition to the standard numbers.

A substitute drawing containing the suggested changes is submitted herewith.

Rejections under 35 U.S.C. § 102

Claims 1, 3-9, 16, 17, 19, 21 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Seaver et al. (US Pub 2002/0192360).

Seaver et al. is cited as disclosing an apparatus for evaluating the triboelectrical properties of at least two samples. Applicants respectfully disagree.

Claim 1 recites at least two samples each in at least one predefined region. The Office has considered the entire drum to be a region. The Office has then incorrectly stated that Seaver et al. recites at least two samples with reference to Fig. 20. Applicants respectfully submit that these are separate samples run at separate times with the drum rotating at different speeds. Seavers et al. even describes the different experiments which come from different examples. Curve A, for example, is a measurement from comparative example 2; Curve B is from comparative example 3; Curve C is from example 3 and Curve D is from example 5. Contrary to the position of the Office Seaver et al. fails to describe, or even suggest, at least one surface with at least two samples each in at least one predefined region even if the entire drum is taken as the region. For, at least, this reason the rejection of claim 1 is improper under 35 U.S.C. 102(b).

Claims 3-9, 16, 17, 19, 21 and 23-27 each ultimately depend from claim 1 and therefore also contain the limitations of claim

1. The rejection of claims 3-9, 16, 17, 19, 21 and 23-27 is improper due to the failure of Seavers et al. to recite, at least, one surface with at least two samples each in at least one predefined region.

Applicants respectfully submit that the rejection of claims 1, 3-9, 16, 17, 19, 21 and 23-27 under 35 U.S.C. 102(b) as being anticipated by Seaver et al. is improper due to the failure of Seaver et al. to recite at least one claimed element. The rejection is traversed.

Rejections under 35 U.S.C. § 103

Claims 2, 13-15, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaver et al. in view of Huizinga et al. (USP 4,328,280).

Seaver et al. has been discussed with reference to claim 1. All comments therein are equally applicable here. In summary, Seaver et al. fails to recite, or even suggest, at least one surface with at least two samples each in at least one predefined region.

The Office admits that Seaver et al. fails to recite one sample being a test sample and the other being a reference

sample. Huizanga et al. is included for teachings which are otherwise lacking in Huizanga et al.

Huizanga et al. specifically recites sequential testing of samples wherein one sample is a reference. One of skill in the art would realized that a reference is only suitable if treated the same way as the test sample. Seaver et al. clearly teaches that the triboelectric charging is a function of time and only one sample can be tested at a time. Both Seavers et al. and Huizinga et al. teach sequential testing. Whereas Huininga et al. attempts to provide a standard, Seavers et al. complicates the measurement by bringing in additional parameters such as drum speed and contact time. If one attempted to combine these teachings they would expect sporadic results due to the inability to consistently treat the reference and test sample the same. Even if they solved this problem they would still not recite the claimed invention since they would still lack any teachings, or suggestion, of a grounded means with at least one surface and at least two samples on a predefined region of the surface. For at least these reasons the rejection is improper.

Applicants respectfully submit that the rejection of claims 2, 13-15, 18 and 22 under 35 U.S.C. 103(a) as being unpatentable

over Seaver et al. in view of Huizinga et al. is improper due to the failure of the references to lead one of skill in the art to the claimed invention. Withdrawal of the rejection is respectfully requested.

Claims 10-12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaver et al. in view of Vanmaele et al. (EP 1243409).

Seaver et al. is discussed previously and all comments are equally applicable herein. The Office admits that Seaver et al. fails to recite an array of samples being evaluated and therefore lacks measuring sequentially the charge of the array of samples.

Vanmaele et al. is cited as teaching the use of an array which is otherwise lacking in Seaver et al. The Office then concludes that it would have been obvious to one of skill in the art to use the array of Vanmaele et al. in the system of Seaver et al. Applicants respectfully submit that this arrangement could only be envisioned in hindsight and, even then, one of skill in the art would not be expected to attempt such a combination.

Seaver et al. clearly demonstrates the time component of charging the sample. If one attempted to combine the teachings of Seaver et al. with those of Vanmaele et al. each sample would have to be charged, and then measured, sequentially. It would be virtually impossible to generate reliable data since the first sample would be charged and then tested. The second sample would be charged, discharged by time, charged again and then tested. One of skill in the art would have to do extensive research just to determine how long to wait between samples and how sequential charging sequences altered the performance. One of skill in the art is provided no motivation for attempting to determine such parameters. The only motivation for considering such a combination is provided in the instant application. It has been a long standing legal principle that the application being examined can not be relied on as a basis of motivation for a combination.

The rejection of claims 10-12 and 28 under 35 U.S.C. 103(a) as being unpatentable over Seaver et al. in view of Vanmaele et al. is improper due to the failure of the reference to motivate one of skill in the art to such a combination and the extensive research required to utilize the combination even if tried.

Applicants respectfully submit that the rejection is traversed and withdrawal is earnestly solicited.

Newly Entered Claims

Claims 29-32 are newly entered claims. Support for claim 29 is provided on page 16, lines 1 and 2 of the specification as filed. Support for claims 30-32 is provided in claims 11, 28 and 12 respectively.

The prior art of record fails to recite the invention as set forth in claims 29-32 and, particularly, fails to recite tribocharging a sample to a plateau value for each sample.

CONCLUSIONS

All claims are in now believed to be in condition for allowance. Notice thereof is respectfully requested.

Respectfully submitted,


Joseph T. Guy, Ph.D.

Agent for Applicants

Registration Number 35,172

Customer No.: 46591

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